

Applicants hereby provisionally elect, with traverse, Group I, claims 1-28 and 56-64 whose claims are drawn to a method of determining a biological sample expression pattern.

the restriction of Group I, and the remaining Groups II, III, IV, V and VI is also traversed.

There are two criteria for a proper restriction requirement, according to MPEP 803:

- (1) the inventions must be independent or distinct as claimed, and
- (2) there must be a serious burden on the Examiner if restriction is not required.

Applicant traverses on the grounds that examination of Group I and the Groups II, III, IV, V and VI together would not be a serious burden.

The claims of Groups I, II and claims 36-42 of Group III are all methods of processing a biological sample or samples. This set of claims includes the three independent claims 1, 29 and 36 which identify three different aspects of this biological sample processing in their preambles, namely, determining a biological sample expression pattern, comparing biological phenotypes, and reducing the complexity of a biological sample. While the different preambles help to clearly identify some interesting aspects of the invention described in the application, the claims are also capable of being presented as a set with a single independent claim since the different aspects identified in the preambles involve the addition of further steps to the basic method recited in claim 36 of Group III. That is, the resolving and determining steps of the method of determining a biological sample expression pattern of claim 1 effectively follow from the application and fractionation steps of claim 36 to provide one use for a sample fractionated according to claim 36. These steps could be recited in dependent form as the method of claim 36 "further comprising" the resolving and determining steps. Similarly, the analyzing step of claim 29 effectively follows from the steps of claim 1 to provide for comparison of the results obtained from practicing the steps recited in claim 1 on a plurality of samples. The kit claims of Group III mirror the Group III method claims and the Examiner has already acknowledged that they should be examined together. Accordingly, it is respectfully submitted that the claims of Groups I, II and III should be consolidated and examined together. As noted above, the claims of Groups I and III could be rewritten so that in each case they all depend from claim 36 ("further comprising"), however, as discussed with Examiner Padmanabhan, this is not believed to be necessary or efficient if a showing is made that they may be readily examined together without

undue burden to the Examiner, such as might be the case for entirely unrelated methods. Should the Examiner require that the claims be rewritten in this manner as a condition to concurrent examination, Applicants are willing to comply and request to be so notified.

With regard to Group IV, Applicants respectfully note that the peptoid claims 49-55 mirror method claim 4, 16-20, 5, 6 and 1 respectively, and, as such, require no further searching beyond which would be necessary for examination of those elected claims of Group I. Accordingly, it is respectfully submitted that the claims of Groups I and IV should be consolidated and examined together.

With regard to Group V, Applicants respectfully note that claim 65 recites a method of processing a sample as recited in claim 36 on a plurality of different substrates. Claim 65 could also be drafted to depend from claim 36 by reciting the method of claim 36 further comprising repeating the method steps for a plurality of affinity supports. As noted above, this is not believed to be efficient or necessary given this showing of the lack of burden to examination together with the claims of Group III. Accordingly, it is respectfully submitted that the claims of Groups III and V should be consolidated and examined together.

Similarly, with regard to Group VI, Applicants respectfully note that claim 71 recites a method of processing a sample as recited in claim 36 with additional processing steps. Claim 71 could also be drafted to depend from claim 36 by reciting the method of claim 36 further comprising the additional steps recited in claim 71. Again, as noted above, this is not believed to be efficient or necessary given this showing of the lack of burden to examination together with the claims of Group III. Accordingly, it is respectfully submitted that the claims of Groups III and VI should be consolidated and examined together.

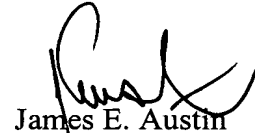
In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, in whole or in part.

Applicant reserves the right to file subsequent applications claiming the non-elected subject matter and does not waive any rights or abandon any non-elected subject matter. Since Applicant has fully and completely responded to the Office Action and has made the required election, it is respectfully submitted that this application is now in order for early action.

If the Examiner believes that a telephone conference would aid the prosecution of this case in any way, he/she is invited to call the undersigned at the telephone number noted below.

If any fees are due in connection with the filing of this amendment, the Commissioner is authorized to charge such fees to Deposit Account 500388 (Order No. CHIRP012).

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP



James E. Austin
Reg. No. 39,489

P.O. Box 778
Berkeley, CA 94704-0778
(510) 843-6200